Docket No. 85804-019800

Appl. No. 09/780,962
Amendment and Response to Office Action

REMARKS

The present application has been reviewed in light of the Office Action dated July 5, 2006. Claims 1 to 36 and 55 to 58 are the pending claims being examined in the application, of which Claims 1, 23, 25, 27 and 29 are independent. Claims 1 to 3, 5, 6, 19 to 29, 36 and 56 to 58 are amended. Reconsideration and further examination are respectfully requested.

Initially, with regard to a formal matter, Applicant renews the request for an initialed copy of the form PTO-1449 to indicate that the art cited in the August 18, 2004 Information Disclosure Statements has been considered and made formally of record.

By the Office Action, Claims 1, 23, 25, 27 and 29 are rejected under 35 U.S.C. § 112, second paragraph. The Examiner contends that the claims omit how table of contents information is received at the network server, which the Office Action contends is an essential element. The Examiner states that he cannot determine which songprint identifier is referenced by the phrase "songprint identifier is derived from digitized content" recited in the last line of the claim. Claim 1 is also being rejected under 35 U.S.C. § 112, second paragraph as being indefinite, for the reason that Claim 1 allegedly claims both an apparatus and method steps making it unclear which category of invention is being claims.

With regard to the 35 U.S.C. § 112, second paragraph rejections alleging that Claims 1, 23, 25, 27 and 29 omit an essential element, reference is respectfully made to MPEP § 2172.01, which provides that in order for an element to be considered essential to the claimed invention, the element must be disclosed as being essential to the invention as described in the specification or in other statements of record. Nothing on the record supports the position taken in the Office Action that the manner by which table of content information is received by the server is essential to the invention. Accordingly, since there is no basis for a rejection under 35 U.S.C. § 112, second paragraph, the rejection should be withdrawn.

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With regard to the phrase "songprint identifier is derived from digitized content", it is respectfully pointed out that the claim language in fact reads "<u>each</u> songprint identifier is derived from digitized content" (emphasis added). It is submitted that the meaning of the phrase is more than sufficiently clear. Accordingly, since the claim language is clear on its face, withdrawal of the 35 U.S.C. § 112, second paragraph is respectfully requested.

With regard to the 35 U.S.C. § 112, second paragraph rejection of the Claim 1 as allegedly being indefinite as to which category of invention is being claimed, without conceding the correctness of the rejection, Claim 1 is being amended herein. Withdrawal of the 35 U.S.C. § 112, second paragraph rejection is therefore respectfully requested.

The Office Action rejects Claims 1 to 36 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,611,812 (Hurtado) and U.S. Patent No. 6,807,632 (Carpentier). Reconsideration and withdrawal of the rejections are respectfully requested.

The Office Action concedes that Hurtado fails to disclose the claimed songprint identifier. The Office Action contends:

> "Hurtado specifically does not disclose wherein each songprint identifier is derived from digitized content. Songprint identifier is derived form the digitized is commonly known knowledge in the distribution of digital asset such as music. For example, Carpentier discloses each songprint identifier is derived from digitized content (col. 25, lines 28 to 31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Hurtado and Carpentier. The motivation would have been to secure delivery and rights management of digital assets over global communication network."

It is respectfully submitted that the hypothetical combination identified in the Office Action is impermissible, since there has been no showing of the motivation in the prior art to make the hypothetical combination suggested in the Office Action. In order to establish a prima facie case of obviousness, the grounds for rejection must include a showing of some suggestion, motivation or teaching in the prior art that the person of ordinary skill would have made the

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hypothetical combination of Hurtado and Carpentier suggested in the Office Action. The Office Action fails to make any reference to the prior art, and the statements made in the Office Action are not substantiated by the record. Furthermore, the alleged "motivation" is so general as to lack any actual motivation, suggestion or teaching to combine the references, let alone to combine the teachings of the references in such a way as to form the claimed combination of elements. Even assuming, arguendo, that Carpentier teaches the claimed songprint identifier (which assumption is in no way conceded), as discussed below, Carpentier discloses a system to facilitate copying of files, while the system of Hurtado is intended to control file transfer and limit copying of files. Thus, as is discussed in more detail below, it is submitted that the hypothetical combination of Carpentier with Hurtado would render the system of Hurtado unsatisfactory for its intended purpose. This provides further support for the lack of a motivation, suggestion or teaching for the hypothetical combination suggested by the Office Action. It is therefore respectfully submitted that in the absence of a showing of a motivation, suggestion or teaching to make the hypothetical combination of Hurtado and Carpentier, the hypothetical combination made in the Office Action is improper, and the rejection of the claims of the present application based on this hypothetical combination should be withdrawn.

Even while the above should provide sufficient reason to withdraw the rejection, it is submitted that assuming that the hypothetical combination is somehow proper (an assumption that is in no way conceded), it is submitted that Carpentier fails to cure the deficiencies of the § 103(a) rejection admitted in the Office Action. The Office Action admits that Hurtado fails to disclose a songprint identifier derived from digitized content.

Claim 1 recites a network server which stores a verification database including master table of contents information and at least one master songprint identifier and has program code operative to cause the server to receive table of contents information and at least one songprint

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identifier from at least one computer and to determine whether to provide authorization

information using said verification database and the received table of contents information and

songprint identifiers, wherein each songprint identifier derived from digitized content.

Carpentier[1] describes a system which facilitates the copying of files to a computer, and

uses a mechanism to determine that the file copy received by the computer is the file requested

by the computer. According to Carpentier, at col. 1, lines 14 to 20:

> "[t]he present invention relates generally to methods and apparatuses for
> encapsulating information, identifying the information, representing the
> information, and facilitating the transfer of the information between
> users, between remote storage and an originating user, or between remote
> storages using computers and digital telecommunication networks."

Thus, Carpentier is used to facilitate the copying of files. Carpentier discloses the use of

a descriptor file, which contains information used to request the files to be copied, and an e-clip

file, which identifies the descriptor file. The computer to which the files are to be copied

receives the e-clip, and identifies the name of the descriptor file using the e-clip file's contents.

Once the descriptor file is received, the computer uses the contents of the descriptor file to

request the files identified in the descriptor file. See Carpentier, Figures 3 and 4. According to

Carpentier, after a file is received by the requesting computer, an MD5 hash of the file is

generated and the generated MD5 hash is compared with an MD5 hash contained in the

descriptor file. If the generated MD5 hash value does not match the MD5 hash value contained

in the descriptor file, Carpentier broadcasts another request for the file. Figure 4, and the

description commencing at col. 13, of Carpentier describes an importer process, which waits for

requested files to be received, confirms that a received file is the file requested, and requests

another copy of the file if the received file is determined not to be the requested file.

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[1] The Office Action cites col. 25, lines 28 to 31 of Carpentier. However, Carpentier does not have a column 25. Accordingly, should the rejection be maintained, clarification of, and an appropriate correction to, the grounds for rejection are necessary and respectfully requested.

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"[i]n step 404, the importer verifies that the cryptographic hash of the file received matches the file identifier that was sent out requesting the file. If the file identifier is not verified, then control is transferred to step 406 where an error handler is activated. Then, in step 408 a request for the entire file is generated and control is transferred back to step 402." See Carpentier, col. 13, lines 10 to 16.

Thus, the MD5 hash value is used to request a file that is to be copied to the requesting computer, to confirm that the file copied to the requesting computer is the file requested, and to determine whether or not to make another request to copy the file to the requesting computer if the received file is not the file requested. This is nothing like the claimed songprint identifier, which is used to determine whether to provide authorization information.

The hypothetical combination suggested in the Office Action therefore lacks the claimed songprint identifier. The § 103(a) rejection of Claims 1 to 22, 29 to 36 and 55 to 58 should be withdrawn, and these claims should be deemed patentable over the hypothetical combination suggested in the Office Action.

Furthermore, and as yet another reason that the § 103(a) rejection should be withdrawn, it is submitted that the suggested hypothetical combination would change the principle of operation of Hurtado and render Hurtado inoperable for its intended purpose. Hurtado operates to control content and the transfer of content such that content is provided only to those requesting user's who can provide a valid license (i.e., license SC 660) consisting of a transaction identifier and the end user's identification. In contrast, Carpentier's principle of operation is to facilitate unfettered copying of files to a requesting computer. In the system disclosed in the Carpentier reference, the e-clip and descriptor files are created so that the files identified in the descriptor file can be copied to the requesting computer, and the MD5 hash value is used to determine whether or not to request another copy of the file. Carpentier's principle of operation is completely opposite that of Hurtado and would render Hurtado inoperable for its intended

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purpose. Therefore, rather than a motivation for the hypothetical combination suggested by the Examiner, the Carpentier reference would teach away from the such a combination and would render Hurtado inoperable for its intended purpose. Thus, for at least this additional reason, Claims 1 to 36 and 55 to 58 of the present application should be patentable over the hypothetical combination suggested in the Office Action.

In accordance with Claims 23, 25 and 27, the claimed network server requests at least one of a plurality of regions of digitized content from the at least one of a plurality of computers from which the table of contents information and songprint identifiers are received. The regions of digitized content are requested as a function of whether or not the received selections of table of contents information correlate with any of the plurality of master table of contents information (Claim 23), the received selections of songprint identifiers correlate with any of the plurality of master table of contents information and songprint identifiers (Claim 25), or both (Claim 27).

Nothing in the hypothetical combination suggested in the Office Action discloses a server receiving table of contents information and a songprint identifier from a computer and requesting regions of digitized content from the computer as a function of whether or not the received information correlates with the received table of contents information, the received songprint identifier, or both. The § 103(a) rejection of Claims 23 to 28 should be withdrawn, and these claims should be deemed patentable over the hypothetical combination suggested in the Office Action.

The dependent claims of the present application each recite additional aspects of the claimed invention, such aspects including the interaction of the elements of the dependent claims with the elements of their base claims. As just a few examples of such additional aspects, Claim 11 recites the additional element of requesting at least one decoy region of digitized content, and Claim 16 recites the additional element that the request comprises a non-decoy region of

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digitized content. The Office Action rejects Claim 11 and cites the "user interface" disclosed at col. 88, lines 29 to 51 of Hurtado, and rejects Claim 16 and cites "the discussion" at col. 4, line 26 to col. 5, line 19.

At col. 88, lines 29 to 51, describes an end user requesting digitized content from a content hosting site after the user's license to obtain a copy of the digitized content has been confirmed. It is unclear how a user requesting a "licensed copy" of digitized content can in any way relate to a network server requesting a decoy region and/or a non-decoy region of digitized content. Carpentier, and in particular col. 4, line 26 to col. 5, line 19, has been reviewed and is not seen to add anything that could in any way teach, suggest or disclose a network server requesting a decoy region and/or a non-decoy region of digitized content.

The Examiner is requested to identify the specific element or elements, by reference number and column and line number, disclosed in either Hurtado or Carpentier which the Examiner considers to correspond to the claimed decoy region of the digitized content requested by the server. The Examiner is likewise requested to provide the same information for the claimed non-decoy region of the digitized content.

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

The Applicant respectfully requests that a timely Notice of Allowance therefore be issued in this case. Should matters remain which the Examiner believes could be resolved in a further telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney at (714) 708-6500 (PST, California). All correspondence should continue to be directed to the below-listed address.

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The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred when charging any payments or credits for this case.

Respectfully submitted,

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Carole A. Quinn
Reg. No.: 39,000
Email: quinnc@gtlaw.com
Phone: (714) 708-6500

GREENBERG TRAURIG, LLP
Met Life Building
200 Park Avenue, 20th Floor
New York, New York 10166
Phone: (212) 801-9200
Fax: (212) 801-6400

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